

Customer No. 22,582
Application No. 09/673,476
Attorney Docket No. 3495.0320-00
(formerly 5394.0011)

REMARKS

Reconsideration of this application is respectfully requested.

Priority

The Office acknowledged that the Oath/Declaration in the instant application included a priority claim to U.S. Application No. 09/060,756, now U.S. Patent No. 6,183,957, but noted that the specification had not been amended to recite this information. Office Action at item 3. Accordingly, Applicants have amended the specification to recite the priority claim, and respectfully request the withdrawal of this objection.

Claim Rejections under 35 U.S.C. § 102(a)

The Office indicated that should Applicants decide not to claim priority to the '756 application, the rejection under 35 U.S.C. § 102(a) under Cole et al. (Nature 393(6685): 537-544 (1998) would be reinstated. Office Action at item 4, citing to item 9 of the Office Action mailed 5/21/2003. Applicants have amended the specification to perfect the priority claim to the '756 application. Consequently, this rejection is now moot.

Double Patenting

The Office rejected claims 53-56 under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over claims 9-11 and 13 of U.S. Patent No. 6,183,957 (the '957 patent). Office Action at item 6. The

Customer No. 22,582
Application No. 09/673,476
Attorney Docket No. 3495.0320-00
(formerly 5394.0011)

Office alleges that the claims are not patentably distinct from one another, because the claims are coextensive in scope. *Id.*

The Office contends that claims 53-56 of the instant case are drawn to purified polynucleotides comprising an open reading frame within SEQ ID NO: 1. Office Action at item 6. The Office further contends that claims 9-11 and 13 of the '957 patent recite a method, and the specification of the '957 patent teaches that this method was used to isolate SEQ ID NO: 1 of the instant application (the '957 patent and the instant application contain identical specifications). *Id.* According to the Office, the scope of the subject matter is therefore not distinct from one another. As support for this contention, the Office cites M.P.E.P. § 806.05, which states, "If nondistinct inventions are claimed in separate applications or patents, double patenting must be held, except where the additional applications were filed consonant with a requirement to restrict in a national application." M.P.E.P. § 806.05.

Applicants submit that the claims in the instant application are consonant with restriction requirements issued by the Office in both the instant application and the '957 patent, to which the current application claims priority. During the prosecution of the '957 patent, the Office required restriction under 35 U.S.C. § 121 between Group I, drawn to methods of isolating a polynucleotide, and Group II, drawn to polynucleotides. '957 patent, Office Action 6/11/99 at item 1. In making the restriction requirement, the Office stated that the inventions were "distinct from each other," arguing that the nucleotides of Group II **could be isolated by a materially different process.** *Id.* at 2

Customer No. 22,582
Application No. 09/673,476
Attorney Docket No. 3495.0320-00
(formerly 5394.0011)

(emphasis added). In other words, the Office did not permit Applicants to pursue both claims reciting a method of isolating nucleic acids and claims to nucleic acids in the same application, because the Office found these to be distinct inventions.

Similarly, in the instant case, the Office required restriction under 35 U.S.C. § 121 between Group I, claims 1-10, drawn to method[s] of isolating nucleic acids, and Group II, claims 11-30, 38-42, 44, 45, 50-51, and 53, drawn to nucleic acids. Office Action mailed 07/01/2002 at 2. In making this restriction, the Office contended that the nucleic acids of Group II and the method of Group I were distinct, arguing that the nucleic acids of Group II **could be made by other methods**. *Id.* at 2 (emphasis added). Thus, the Office again contended that the inventions were patentably distinct because the nucleic acids of Group II could be made by other methods than those recited in the claims in Group I.

Because the Office required restriction between these inventions in both applications, and because the pending claims recite polynucleotides that the Office contended were distinct from claims 9-11 and 13 in the '957 patent because they could be made by other methods, it is impermissible to now reject these claims under obviousness-type double patenting. Accordingly, Applicants respectfully request withdrawal of this rejection, and the allowance of the pending claims.

Customer No. 22,582
Application No. 09/673,476
Attorney Docket No. 3495.0320-00
(formerly 5394.0011)

If there is any fee due in connection with the filing of this Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 8, 2005

By: 

Kenneth J. Meyers
Reg. No. 25,146
Phone: (202) 408-4000
Fax: (202) 408-4400
E-mail: ken.meyers@finnegan.com